

REMARKS

Claims 8 to 21 are pending.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for allowing claims 11, 14, 16, 18 and 19.

Claims 8, 11 and 12 were objected to for certain minor informalities.

While the objections may not be agreed with, to facilitate matters, claims 8, 11 and 12 has been rewritten so as to obviate the objections. Approval and entry are respectfully requested, as is withdrawal of the objections.

Claims 8, 9, 13, and 15 were rejected under 35 U.S.C. 102(a) as anticipated by, or alternatively as obvious under 35 U.S.C. 103(a) over, Minamiura et al., U.S. Patent Application Publication No. 2003/0052646 ("Minamiura").

As regards the anticipation rejections of the claim, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claim 8 has been rewritten to include the “assuming” feature of allowed claim 11. Accordingly, claim 8, as presented, is allowable for essentially the same reasons, as are its dependent claims 9, 13 and 15. It is therefore respectfully requested that the anticipation and obviousness rejections be withdrawn as to claims 8, 9, 13 and 15.

Claim 10 was rejected under 35 U.S.C. 103(a) as obvious over, Minamiura et al., U.S. Patent Application Publication No. 2003/0052646 (“Minamiura”) in view of Tate et al., U.S. Patent No. 6,441,586.

While the rejection may not be agreed with, to facilitate matters, base claim 8 has been rewritten to include the “assuming” feature of allowed claim 11. Accordingly, claim 8, as presented, is allowable for essentially the same reasons, as is its dependent claim 10m since the secondary Tate reference does not cure and is not asserted to cure the

critical deficiencies of the primary reference. It is therefore respectfully requested that the obviousness rejection be withdrawn as to claim 10.

Claims 12, 17 and 20 were rejected under 35 U.S.C. 103(a) as obvious over, Minamiura et al., U.S. Patent Application Publication No. 2003/0052646 (“Minamiura”) in view of U.S. Patent Application No. 2003/0146737 (“Kadouchi”).

Claim 21 was rejected under 35 U.S.C. 103(a) as obvious over, Minamiura et al., U.S. Patent Application Publication No. 2003/0052646 (“Minamiura”) in view of U.S. Patent Application No. 2003/0146737 (“Kadouchi”), and further in view of Tate et al., U.S. Patent No. 6,441,586.

While the rejections may not be agreed with, to facilitate matters, claim 12 has been rewritten to include the “assuming” feature of allowed claim 11. Accordingly, claim 12, as presented, is allowable for essentially the same reasons, as are its dependent claims 17 and 20. It is therefore respectfully requested that the obviousness rejections be withdrawn as to claims 12, 17, 20 and 21.

Accordingly, claims 8 to 10, 12, 13, 15, 17, 20 and 21 are allowable – like allowed claims 11, 14, 16, 18 and 19.

CONCLUSION

In view of the above, it is respectfully submitted that all of the presently pending claims 8 to 10, 12, 13, 15, 17, 20 and 21 are allowable – like allowed claims 11, 14, 16, 18 and 19. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since they have been obviated. Since all issues raised have been addressed, an early and favorable action on the merits is respectfully requested.

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Respectfully Submitted,

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